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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,933	12/10/2003	Khalid Hussain	38494-00157D	7316
36754	7590	12/20/2004	EXAMINER	
LEWIS AND ROCA, LLP 40 N. CENTRAL AVE. PHOENIX, AZ 85004			HAMDAN, WASSEEM H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/732,933

Applicant(s)

HUSSAIN, KHALID

Examiner

Wasseem H Hamdan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 17-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/10/03; 10/08/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's Amendment and Response to Restriction Requirement in the reply filed on October 27, 2004 is acknowledged. The restriction requirement that mailed on 09/21/2004 has been withdrawn in lieu of the amendment and in order to expedite prosecution of the case. Accordingly, all pending claims 1 and 17-29 are currently under consideration (examination).

### *Specification*

2. The disclosure is objected to because of the following informalities:

- a. **Field of the Invention:** It should have separate heading about "Related Art", in addition the information about the parent case 10/235,136 should be updated to include that the application 10/235,136 is a US Patent now US 6,694,874 B1, Patented on February 24, 2004. Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

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- b. The Abstract and the Field of the Invention Summary of the Invention does not disclose the creation a pictorial cancellation mark. Please see below:

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### ***Title***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: -- CREATING AND SELECTING DIGITAL CANCELLATION MARK --.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of the method recited in claims 1 and 27, should be presented in a flow chart and must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

5. Claim 27 is objected to because of the following informalities: claim 27, line 3, recites "by a customer" it should be "by the (or said) customer". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 17 and 21-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Sansone (US Patent 6,415,336 B1).

Regarding claim 1, Sansone discloses a method of applying a cancellation mark to a mailpiece [FIG. 3; column 5, lines 51-56] comprising the steps of:

Creating [column 2, lines 10-12; column 3, lines 12-13; column 5, lines 35-37; 142; 146; column 8, lines 20-23 (according to Merriam-Webster's Collegiate Dictionary, tenth edition, 1998, pages 272-273, create is the same as produce) a pictorial cancellation mark in electronic form [column 5, lines 51-56; 40; 26] ; and

Applying said pictorial cancellation mark to a mailpiece [column 5, lines 51-56; 40; 26; 50].

Regarding claim 17, Sansone discloses transmitting [30] said pictorial cancellation mark to a printer [146; the communication and the signal between 40b – 30 – 52 – 60]; and

Printing [60] said pictorial cancellation mark on a mailpiece [Fig. 7c; 146].

Regarding claim 21, Sansone discloses printing of the pictorial cancellation mark on a mailpiece cancels the postage indicia of the mailpiece [50; 60; Fig. 7c; 146].

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Regarding claim 22, Sansone discloses applying at least two distinct colors to the mailpiece [142; 146 (black and white considered to be two distinct colors)].

Regarding claim 23, Sansone discloses storing said pictorial cancellation mark in an electronic memory [42; column 1, lines 65-67].

Regarding claim 24, Sansone discloses said electronic memory further comprises a computer digital memory [42, Read-Write memory is a digital memory. According to "The IEEE Standard Dictionary of Electrical and Electronics Terms, sixth Edition, page 878].

8. Claims 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone (US Patent 6,415,336 B1) in view of Beasley (US Publication No. US 2002/0149195 A1).

Regarding claim 18, Sansone discloses the essential elements of the claimed invention except for scanning an image with a scanner. Beasley discloses scanning an image with a scanner [102; page 3, section [0030], line 13]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Sansone by including scanning an image with a scanner, since Beasley teaches that scanning an image with a scanner would be beneficial for the purpose of detecting and storing the image and hence printing the image on a desired media in a desired location of the media to prepare the image be a cancellation mark [102; 110; 116; 118; page 2, section [0014]; section [0035], lines 1-3].

Regarding claim 25, Sansone discloses the essential elements of the claimed invention except for the step of adjusting the dimensions of the pictorial cancellation mark to a preferred size. Beasley discloses the step of adjusting the dimensions of the pictorial cancellation mark to a preferred size [114; page 1, section [0012], lines 8-9; section [0014], lines 5-7. In Beasley, the image has been scanned, stored in the database, sized and then ink cancellation stamp has been applied over it]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Sansone by including the step of adjusting the dimensions of the pictorial cancellation mark to a preferred size, since having the step of adjusting the dimensions of the pictorial cancellation mark to a preferred size would be beneficial for the purpose of having the user a desirable image size to fit the substrate.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone (US Patent 6,415,336 B1) in view of Patton et al. (US Patent 6,503,329 B2).

Regarding claim 19, Sansone discloses the essential elements of the claimed invention except for the printer comprises an ink jet printer. Patton et al. discloses the printer comprises an ink jet (or inkjet) printer [400; column 6, lines 30-31]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of



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Sansone by including the printer comprises an ink jet printer, since having the printer comprises an ink jet printer would be beneficial for the purpose of printing high quality image.

11. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone (US Patent 6,415,336 B1) in view of Pierce (US Patent 6,427,139 B1).

Regarding claim 20, Sansone discloses the essential elements of the claimed invention except for the printer comprises a laser jet printer. Pierce discloses the printer comprises a laser jet printer [column 3, line 46]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Sansone by including the printer comprises a laser jet printer, since having the printer comprises a laser jet printer would be beneficial for the purpose of printing high quality image.

12. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone (US Patent 6,415,336 B1) in view of Versaci (US Patent 4,641,578).

Regarding claim 26, Sansone discloses the essential elements of the claimed invention except for wherein said pictorial cancellation mark includes a bullseye cancellation. Versaci discloses wherein said pictorial cancellation mark includes a bullseye (or bulls eye) cancellation [column 1, lines 35-37; column 3, line 46]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Sansone by including wherein said pictorial cancellation mark includes a bullseye cancellation, since having wherein said pictorial cancellation mark includes a bullseye cancellation would be

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beneficial for the purpose of including specific information such as the date and name of the post office.

13. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone (US Patent 6,415,336 B1) in view of Versaci (US Patent 4,641,578) and further in view of Gustafson et al. (US Publication No. US 2002/0025085 A1).

Regarding claims 27 and 28, Sansone discloses the essential elements of the claimed invention except for providing a set of pictorial cancellation marks; and selecting and applying a particular pictorial cancellation mark. Versaci discloses providing a set of pictorial cancellation seals "marks"; and selecting and applying a particular pictorial cancellation seal "mark" [column 1, lines 32-36. In Versaci issuing every day a different cancellation seal "mark" is the same as providing a set of pictorial cancellation marks, selecting and applying a particular pictorial cancellation mark]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Sansone by including the step of providing a set of pictorial cancellation marks; and selecting and applying a particular pictorial cancellation mark, since having to provide a set of pictorial cancellation marks, to select and to apply a particular pictorial cancellation mark would be beneficial for the purpose of having a unique cancellation seal "mark" on the mailpiece for different day (with the broadest reasonable interpretation of the claim language, please note that a customer is a user, and the postal officials "post office employees" are considered to be users. Therefore the postal officials are considered to be customers).

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Although the examiner's interpretation to the "customer" claim language as set forth in the office action. The examiner would like to document that even Versaci is silent about the post office employees are being the customers. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Versaci by expanding the access to the cancellation seal from the post office officials to the customer by including the step of providing the cancellation marks to a customer and selecting and applying the cancellation mark by the customer, since having the customer to have access to cancellation mark would be beneficial for the purpose of having the customer the flexibility to print a personalize image on a mailpiece for aesthetic reasons.

Sansone and Versaci together disclose the essential elements of the claimed invention. However, Versaci is silent about the set of images to be automated (being in database for customization). Gustafson et al. discloses the set of images to be automated [FIG. 1; column 1, section [0011], lines 8-10]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to further modify the teachings of Sansone by including the set of images to be automated, since having the set of images to be automated would be beneficial for the purpose of having the user the flexibility to choose his own desired image.

Regarding claim 29, Sansone discloses printing of the pictorial cancellation mark on a mailpiece cancels the postage indicia of the mailpiece [50; 60; Fig. 7c; 146].

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wasseem H. Hamdan

December 6, 2004